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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,747	10/11/2001	Maxie A. Durel-Crain	P01269US (98151.1P2)	9363

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 04/19/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/975,747	DUREL-CRAIN, MAXIE A.
	Examiner	Art Unit
	Dennis Ruhl	3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25, 27 and 28 is/are rejected.
- 7) Claim(s) 8-12 and 26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,8,18,19,24, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1,8, the language "attached to a tampon" is confusing because a tampon has already been claimed. How many tampons are in the scope of this claim? Should the term "a tampon" be changed to "said tampon"?

With respect to claim 18, the claim from which it depends is not a method claim so this claim is indefinite.

With respect to claims 18,19, Claim 11 is an article claim that recites the accessory as being a soft hollow spherical body. It is not clear what the accessory is made from. Does it have the structure of claim 11 or claim 18,19? The language of claims 18,19 contradicts the language of claim 11.

With respect to claim 24, how can the range for the width be recited as being from .64-1.9cm when the range set forth in claim 23 is .32 to 1.3? The range of claim 24 includes values that are not in the range of claim 23. This is claiming a range and then expanding the range in a dependent claim, which is improper. This claim is considered indefinite because it is not known what the range for the width is. Is it the range of claim 23 or claim 24?

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Yeo (5533990). Yeo discloses a tampon 10 that has a string 16. See column 4, lines 8-14 where it is disclosed that the string may have a length of from 2 to 8 inches, which satisfies the claimed limitation.
5. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (4332251). Thompson discloses a tampon 3 with a string 6. Thompson discloses attaching an accessory 4 to the tampon string. The accessory will inherently provide the functional language claimed.
6. Claims 23,25, are rejected under 35 U.S.C. 102(b) as being anticipated by Petrus et al. (5417224). Petrus discloses a tampon 12 and a string 16. See column 7, lines 13,14 where a width is disclosed that satisfies the claimed range. The disclosed width of 0.4cm is about 0.48 as claimed.
7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21,22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeo (5533990). Yeo discloses the invention substantially as claimed. Yeo does not disclose the claimed length for the string. Yeo discloses a length of up to 8 inches for

Art Unit: 3761

the string. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the string of Yeo 9 inches in length or even 11 inches in length to provide more string for the user to grasp and manipulate during removal of the tampon. In the event the tampon is inserted further up the vaginal canal than intended, this would ensure that enough string remained outside the body to allow the user to effectively grasp to remove the tampon.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson. Thompson discloses the invention substantially as claimed. Thompson does not disclose that the string has the claimed length. It is well known in the tampon art that strings have a length of 3 inches and it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tampon string of Thompson with a length of 3 inches.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 1-7,14,15,17,27,28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,5-10 of prior U.S. Patent No. 6312419. This is a double patenting rejection.

Art Unit: 3761

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 13,16,18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6312419. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant pending claims are simply broader than and fail to recite some of the language of patented claim 10. *In re Goodman* 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Another reason for a terminal disclaimer is to maintain common ownership of claims of overlapping scope.

14. Claims 8-12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

15. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Petrus (5954685) discloses a tampon with a string.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DR
April 16, 2002



DENNIS RUHL
PRIMARY EXAMINER